APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,860	07/21/2003	Claribel Chan	14066-011001 / 2002P00234	6527

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EXAMINER
COUGHLAN, PETER D

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/624,860	CHAN ET AL.
	Examiner	Art Unit	
	Peter Coughlan	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/24/2003*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Detailed Action

1.   Claims 1-31 are pending in this application.

Abstract

2.   The abstract contains indicators that do match the flow chart on the cover

page of the application. This results in confusion about the overall design of the

invention. Removing the indicators eliminates the confusion.

35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful
> improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-31 are rejected under 35 U.S.C. 101 for nonstatutory subject

matter. The computer system must set forth a practical application of that § 101

judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175

USPQ at 676-77. The invention is ineligible because it has not been limited to a

substantial practical application. There needs to be a specific purpose that the

invention fulfills. 'A business solution', 'a method' or 'causing one or more

machines...' is not a real world application. The result has to be a practical

application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101.

There is no clear purpose for the invention. Is it a solution for a logistic problem for a shipping firm? Is the invention intended use for a computer network maintenance? Is the intended use for forecasting future human resources? Such results have not been claimed.

The invention must be for a practical application and either:

1) specify transforming (physical thing) or

2) have the FINAL RESULT (not the steps) achieve or produce a

useful (specific, substantial, AND credible),

concrete (substantially repeatable/ non-unpredictable), AND

tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical

<u>application but the claim is broader than the disclosure such that it does not</u>

<u>require the practical application, then the claim must be amended</u>.

Claims that outline a design and algorithm for problem solving without a

practical application are not statutory.

Claim Rejections - 35 USC § 112

4.   Claims 1, 3, 9, 10, 11, 12, 13, 15, 25 are rejected under 35 U.S.C. §112,

second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention. All

these claims use the word 'manage'. 'Manage' fails to clearly state what is

required or needed. The word is vague at best. A full explanation of the

deficiency of the clams should be supplied.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35
U.S.C. 102 that form the basis for the rejections under this section made in this
Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section
122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before
the invention by the applicant for patent, except that an international application filed under
the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an
application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

Claims 1-31 are rejected under 35 U.S.C. 102(e) (hereinafter referred to as **Bowman**) being anticipated by Bowman-Amuah, U.S. 6339832.

Claim 1.

Bowman anticipates design a business solution with user parameters and user-selectable, pre-defined business objects and pre-defined technology objects (**Bowman,** C14:34-41; 'Parameters', 'business objects' and 'technology objects' of applicant is equivalent to 'domain', 'objects' and 'classes' of Bowman.) manage the business solution designed by the user. (**Bowman,** C21:52-61)

Claim 2.

Bowman anticipates a portal layer, (**Bowman,** C31:57 through C32:5; 'Portal layer' of applicant is equivalent to 'communication services' and communication fabric' of Bowman.) a software application layer (**Bowman,** C3:48-50; 'Software application layer' of applicant is equivalent to 'software development and management' of Bowman.) a data repository. (**Bowman,** C37:46-53; 'Data repository' of applicant is equivalent to 'central design repository' of Bowman.)

Claim 3.

Bowman anticipates the first and second agents providing graphical user interfaces to the first and second software applications; the first software

application being operable to allow a user to design a business solution with user parameters and user-selectable, pre-defined business objects and pre-defined technology objects; the second software application being operable to allow a user to manage the business solution. (**Bowman,** C116:52-57; The 'first agent' and 'second ' agent of applicant is equivalent to 'system software' and 'management systems' of Bowman.)

Claim 4.

Bowman anticipates stores the pre-defined business objects and pre-defined technology objects. (**Bowman,** C37:46-53, C53:23-35; 'business objects' of applicant is equivalent to 'objects' of Bowman. 'Components' of applicant is what comprises classes (technology objects) of Bowman.)

Claim 5.

Bowman anticipates an interview module operable to display questions to a user and receive answers from the user to be used by the first software application. (**Bowman,** abstract' 'Interview module' of applicant is illustrated by entering an 'exception' and answers are provided by the 'exception response table' of Bowman.)5

Claim 6.

Bowman anticipates a business process engineer application operable to receive user parameters and design business processes with the pre-defined

business process objects. (**Bowman,** abstract; When the user enters the

parameters (equivalent to 'exception' of Bowman) this function is equivalent to a

'business process engineer' of applicant.)6

Claim 7.

Bowman anticipates solution technology engineer application operable to

receive user parameters and design technology solutions with the pre-defined

technology objects. (**Bowman,** abstract; 'Solution technology engineer' of

applicant is equivalent to responding with the correct 'exception response' that is

listed in the 'exception response table' of Bowman.)7

Claim 8.

Bowman anticipates stores a plurality of business solutions, the second

software application being operable to allow a user to select one of the business

solutions. (**Bowman,** C37:46-53; 'Business solutions' of applicant is equivalent to

'application objects' of Bowman. 'User to select' of applicant is equivalent to

'check-in/check-out' of Bowman.)

Claim 9.

Bowman anticipates a knowledge base management application operable

to allow a user to manage a knowledge base. (**Bowman,** C55:59-67; 'Knowledge

base management' of applicant is equivalent to 'document management' of

Bowman.)

Claim 10.

Bowman anticipates a project management application operable to allow a user to manage a project from a project repository. (**Bowman,** C149:50-65 and C31:28-33; 'Project management' of applicant is illustrated by 'how to use project specific application frame work' of Bowman (Bowman does not give it a specific name.))

Claim 11.

Bowman anticipates an integrated implementation management application operable to allow a user to manage an integrated implementation from an implementation repository. (**Bowman,** C7:36-37 and Figure 127; Bowman illustrates the modules of a implementation interface which enables the user to integrate implementation. (Bowman just does not give it a specific name.))

Claim 12.

Bowman anticipates a methodology management application operable to allow a user to manage a methodology from a methodology repository. (**Bowman,** C4:2-4 and Fig. 43)

Claim 13.

Bowman anticipates a solution landscape management application operable to allow a user to manage a solution landscape from a landscape version repository. (**Bowman**, C37:46-53; 'Solution landscape management' of applicant is equivalent to 'version control' of Bowman.)

Claim 14.

Bowman anticipates a business process analyzer(**Bowman,** C161:32-41; Bowman illustrates analyzing 'business use case') and a control object repository. (**Bowman,** C37:46-53)

Claim 15.

Bowman anticipates a business process object management application and a technology object management application operable to allow a user to manage business process objects and technology objects. (**Bowman,** C48:18-26 and C23:35-39; 'Business process object management' of applicant is equivalent to 'direct manipulation services' of Bowman. 'Technology object management' of applicant is equivalent to 'delivery vehicle reference' of Bowman.)

Claim 16.

Bowman anticipates a technology component identifier and a classification repository. (**Bowman,** C192:13-25 and C130:51-64; 'Component identifier' of applicant is illustrated in operation 5410 of Bowman. 'Classification repository' of applicant is equivalent to 'partitioned business component' of Bowman.)

Claim 17.

Bowman anticipates stores a plurality of user-selectable solution

determination structures, each solution determination structure having a plurality

of parameters and solution determination procedures. (**Bowman,** C14:34-43;

'Determining structures' of applicant is equivalent to 'frameworks' of Bowman.)

Claim 18.

Bowman anticipates each solution determination procedure comprises

control objects linked to routines. (**Bowman,** C20:24-32; 'Solution', 'routines' and

'control objects' 'meet a specific set of user or application requirements',

'applications' and 'components' of Bowman.)

Claim 19.

Bowman anticipates stores a solution determination structure instantiation

having a user-selectable initiative, business area, business process and business

activity. (**Bowman,** C21:52-61; 'Business area', 'business process' and 'business

activity' of applicant is equivalent to 'core business', 'architecture' and

'infrastructure' of Bowman.)

Claim 20.

Bowman anticipates solution determination structure instantiation is linked

to a plurality of templates, the templates being linked to pre-defined business

process objects and pre-defined technology objects. (**Bowman,** C14:34-41 and

C131:22-35; 'Template' of applicant is equivalent to 'template' of Bowman.

Bowman equates 'template' as a functioning 'framework')

Claim 21.

Bowman anticipates templates comprising a solution template (**Bowman,**

C15:9-32), a business object template (**Bowman,** C14:52-64), a technology

object template (**Bowman,** C13:30-42) and a project template. (**Bowman,**

C31:28-33)

Claim 22.

Bowman anticipates provides a primary work area with active solution

variants and inactive solution variants. (**Bowman,** C116:52-57; 'Primary work

area' of applicant is equivalent to 'system software' of Bowman.)

Claim 23.

Bowman anticipates a primary work and an alternate work area.

(**Bowman,** C116:52-57; 'Alternate work area' of applicant is equivalent to

'management system' of Bowman.)

Claim 24.

Bowman anticipates an exchange infrastructure operable to allow

applications in the application layer to communicate with external applications.

(**Bowman,** C31:57 through C32:5; 'Exchange infrastructure' of applicant is equivalent to items '1006, 1008 and 1010' of Bowman.)

Claim 25.

Bowman anticipates providing at least first and second software applications, the first software application being operable to allow a user to design a business solution with user parameters and user-selectable, pre-defined business process objects and pre-defined technology objects, the second software application being operable to allow a user to manage the business solution (**Bowman,** C116:52-57; The 'first agent' and 'second ' agent of applicant is equivalent to 'system software' and 'management systems' of Bowman.); and providing a data repository comprising the pre-defined business process objects and pre-defined technology objects. (**Bowman,** C37:46-53; 'Data repository' of applicant is equivalent to 'central design repository' of Bowman.)

Claim 26.

Bowman anticipates an exchange infrastructure operable to allow applications in the application layer to communicate with external applications. (**Bowman,** C31:57 through C32:5; 'Exchange infrastructure' of applicant is equivalent to items '1006, 1008 and 1010' of Bowman.)

Claim 27.

Bowman anticipates a plurality of solution determination structures.

(**Bowman,** C14:34-43; 'Determining structures' of applicant is equivalent to

'frameworks' of Bowman.)

Claim 28.

Bowman anticipates a plurality of user-selectable business process

templates and technology object templates. (**Bowman,** C14:34-41 and C131:22-

35; 'Template' of applicant is equivalent to 'template' of Bowman. Bowman

equates 'template' as a functioning 'framework')

Claim 29.

Bowman anticipates prompting a user to select at least one business

process object and one technology object; receiving user parameters; designing

a business solution using the selected business process object, technology

object and user parameters. (**Bowman,** C14:34-41; 'Parameters', 'business

objects' and 'technology objects' of applicant is equivalent to 'domain', 'objects'

and 'classes' of Bowman.)

Claim 30

Bowman anticipates to cause one or more machines to organize business

process objects, technology objects and user parameters in a linked structure.

(**Bowman,** C120:7-19; 'To organize business process' of applicant is

demonstrated by 'business logic' of Bowman.)

Claim 31.

Bowman anticipates cause one or more machines to provide solution

templates. (**Bowman,** C109:14-20; Providing 'solution templates' is

demonstrated by 'report services' of Bowman.)

Conclusion

6.   The prior art of record and not relied upon is considered pertinent to the

applicant's disclosure.

-U. S. Patent 5903759: Sun

-U. S. Patent 6378066: Lewis

-U. S. Patent 6336212: Gray

-U. S. Patent 6311327: O'Brien

-U. S. Patent 6286132: Tanaka

-U. S. Patent 6282701: Wygodny

-U. S. Patent 6266805: Nwana

-U. S. Patent 6263457: Anderson

-U. S. Patent 6216237: Klemm

-U. S. Patent 6206584: Hastings

-U. S. Patent 6205561: Santerre

-U. S. Patent 6189142: Johnston

-U. S. Patent 6158023: Ubukata

-U. S. Patent 6131185: Coskun

-U. S. Patent 6126329: Bennett

-U. S. Patent 6035422: Hohl

7.   Claims 1-31 are rejected.

Correspondence Information

8.   Any inquiry concerning this information or related to the subject disclosure
should be directed to the Examiner Peter Coughlan, whose telephone number is
(571) 272-5990. The Examiner can be reached on Monday through Friday from
7:15 a.m. to 3:45 p.m.

        If attempts to reach the Examiner by telephone are unsuccessful, the
Examiner's supervisor David Vincent can be reached at (571) 272-3687. Any
response to this office action should be mailed to:

        Commissioner of Patents and Trademarks,

        Washington, D. C. 20231;

Hand delivered to:

        Receptionist,

Customer Service Window,

Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 273-8300 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from

the Patent Application Information Retrieval (PAIR) system. Status information

for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have any questions on access to Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll free).

Peter Coughlan

8/28/2006